



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/855,042

05/14/2001

David A. Solin

1220

8654

29855

7590

11/03/2006

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,
L.L.P.
20333 SH 249
SUITE 600
HOUSTON, TX 77070

EXAMINER

ROBINSON, GRETA LEE

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,042

Applicant(s)

SOLIN, DAVID A.

Examiner

Greta L. Robinson

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No: _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 2-7 and 9-21 are pending in the present application.
2. Claims 1 and 8 have been cancelled. Claims 3, 5, 6, 10, 12, 13, 19 and 20 have been amended.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-7, 9-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of claims are geared to an abstract idea that does not comprise a useful concrete tangible result for updating a computer system. Note the preamble of independent claim 3 recites "updating a computer system", *while* the body of the claim recites "**updating** the computer system responsive to at least **the first set of update information** received"; *however* the claim does not give an outcome for the limitation of "requesting a **second set of update information** responsive to at least the size of the first set of update information" [see claim 3 lines 4-5]. The limitations of independent claim 10 are parallel claim 3, and is therefore rejected for similar reasons. Regarding independent claims 5, 12 and 19, the claim does not specifically recite an "updating step" for the second and third set of update information. Also independent claim 15 does not specifically recite

Art Unit: 2168

performing an updating function of the computer system; and omits limitation as to procedures for **exceeding a storage amount** [see claim 15 lines 1-4; also note specification page 25 lines 20-22]. Claims 2, 4, 6, 7, 9, 11, 13, 14, 20 and 21 are rejected based on dependency.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 15-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of a holding area manager does not appear to be described properly at page 26 lines 3-15, which states that it is not necessary to attempt to store the channel update and determine if the update will overflow the holding area. The passage appears to omit description.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2168

8. Claims 2-7 and 9-21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Regarding claims 2-7, 9-14, and 19-21 the claim omits **channel index** [see page 2-3, and page 9 lines 3-23], also the **installer/deleter 214**, **holding area manager 222** appears to be important elements of the embodiments of the invention note Figures 2-3 page detailed description of specification. Regarding claims 15-18 the claims appear to omit steps taken or a **procedure for exceeding a storage amount** [see claim 15 lines 1-4; page 25 lines 20-22, also page 2 lines 8-13].

Response to Arguments

9. Applicant's arguments with respect to claims 2-7 and 9-21 have been considered but are moot in view of the new ground(s) of rejection. In the response Applicant argued with respect to the rejection cited under 35 USC 101 claims 3, 5-6, 10, 12-13, and 19-20 have been amended. Also the claims 3, 6, 10, 13 and 20 have been amended to overcome the rejection cited under 35 USC 112 second paragraph. However this is not found persuasive, note new grounds of rejection cited supra.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Miller et al. US Patent 6,535,911

Kato et al. US Patent 6,470,496

Sutter US Patent 6,446,092

Ohran US Patent 6,397,307

Purcell US Patent 6,286,138

Gerard et al. US Patent 6,092,079


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/855,042
Art Unit: 2168

Page 6



GRETA ROBINSON
PRIMARY EXAMINER
Greta Robinson
Primary Examiner
October 31, 2006